

### **III. Remarks**

#### **A. Status of the Application**

Claims 1 and 3-19 were previously pending and remain pending. No claims are added or canceled by the present paper. Reconsideration of this application in light of the above amendments and the following remarks is respectfully requested.

#### **B. Claim Rejections Under 35 U.S.C. § 102**

Claims 1 and 3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,030,201 to Palestrant ("Palestrant patent").

The PTO provides in MPEP § 2131 that

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (emphasis added)

Therefore, to sustain the rejection of claims 1 and 3 the Palestrant patent must disclose each and every element in as complete detail as recited in the claims.

With respect to amended independent claim 1, however, the Palestrant patent at least fails to disclose an enucleation device comprising:

"a distal end comprising a cutting cap comprising a plurality of deformable blades sized and shaped for cutting a portion of a spinal segment, the deformable blades deformable between an orthogonally-expanded cutting configuration where the deformable blades are generally splayed outward from one another and an insertion configuration where the deformable blades extend generally parallel to one another, wherein the orthogonally-expanded cutting configuration is a neutral position for the deformable blades and the insertion configuration is a deformed position for the deformable blades such that when the deformable blades are not deformed the deformable blades return to the orthogonally-expanded cutting configuration;

a flexible shaft between the proximal end and the cutting cap, the flexible shaft connected to the cutting cap; and

a motor adapter positioned adjacent to the proximal end, the motor adapter configured to connect the enucleation device to a

motor drive for rotating the flexible shaft to cause rotation of the cutting cap.”

Accordingly, the Palestrant patent fails to disclose each and every element in as complete detail as recited in claim 1. Claim 3 depends from and further limits claim 1. Thus, Applicants request that the § 102 rejection of claims 1 and 3 over the Palestrant patent be withdrawn.

### C. Claim Rejections Under 35 U.S.C. § 103

#### 1. Ratcliff and Palestrant

Claims 4-7, 11, 12, 14, 18, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,709,697 to Ratcliff et al. (“Ratcliff patent”) in view of the Palestrant patent.

The PTO provides in MPEP § 2131 that

“The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.”

The Examiner clearly cannot, using the Ratcliff and Palestrant patents, establish a *prima facie* case of obviousness in connection to claim 4-7, 11, 12, 14, 18, and 19 for at least the following reason.

35 U.S.C. § 103(a) provides, in part, that:

“A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time of the invention was made to a person having ordinary skill in the art . . .”  
(emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

Claims 4 and 11 each recite “providing the enucleation device of claim 1.” As previously discussed, the Palestrant patent fails to disclose all of the limitations recited in claim 1. Similarly, with respect to claim 1 the Ratcliff patent also fails to disclose an enucleation device comprising:

“a distal end comprising a cutting cap comprising a plurality of deformable blades sized and shaped for cutting a portion of a spinal segment, the deformable blades deformable

between an orthogonally-expanded cutting configuration where the deformable blades are generally splayed outward from one another and an insertion configuration where the deformable blades extend generally parallel to one another, wherein the orthogonally-expanded cutting configuration is a neutral position for the deformable blades and the insertion configuration is a deformed position for the deformable blades such that when the deformable blades are not deformed the deformable blades return to the orthogonally-expanded cutting configuration;

a flexible shaft between the proximal end and the cutting cap, the flexible shaft connected to the cutting cap; and

a motor adapter positioned adjacent to the proximal end, the motor adapter configured to connect the enucleation device to a motor drive for rotating the flexible shaft to cause rotation of the cutting cap.”

Accordingly, even when combined the Ratcliff and Palestrant patents fail to disclose all of the recited limitations of claim 1. Thus, the Ratcliff and Palestrant patents necessarily fail to disclose all of the limitations of claims 4 and 11, that each require “providing the enucleation device of claim 1.” Claims 5-7 depend from and further limit claim 4, while claims 12 and 14 depend from and further limit claim 11. Therefore, a *prima facie* case of obviousness cannot be established with respect to claims 4-7, 11, 12, and 14 based on the Ratcliff and Palestrant patents. Thus, Applicants request that the § 103 rejection of claims 4-7, 11, 12, and 14 be withdrawn.

Similarly, with respect to independent claim 18, neither the Ratcliff patent nor the Palestrant patent disclose an enucleation device comprising:

“a distal end comprising a cutting cap sized and shaped for cutting a portion of a spinal segment, the cutting cap comprising a plurality of deformable blades comprising a shape memory alloy, wherein the deformable blades are deformable between an orthogonally-expanded cutting configuration where the deformable blades are generally splayed outward from one another and an insertion configuration where the deformable blades extend generally parallel to one another, wherein the shape memory alloy of the deformable blades is processed such that the orthogonally-expanded cutting configuration is a neutral position for the deformable blades and the insertion configuration is a deformed position for the deformable blades such that when the deformable blades are not deformed the deformable blades return to the orthogonally-expanded cutting configuration;

a shaft between the proximal end and the cutting cap, the shaft attached to the cutting cap; and

a motor adapter positioned adjacent to the proximal end,  
the motor adapter configured to connect the shaft to a motor drive  
configured to rotate the shaft to cause rotation of the cutting cap.”

Accordingly, even when combined the Ratcliff and Palestrant patents fail to disclose all of the recited limitations of claim 18. Claim 19 requires in part “providing the enucleation device of claim 18.” Therefore, a *prima facie* case of obviousness cannot be established with respect to claims 18 and 19 based on the Ratcliff and Palestrant patents. Thus, Applicants request that the § 103 rejection of claims 18 and 19 be withdrawn.

## **2. Ratcliff, Palestrant, and Groshong**

Claims 8 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Ratcliff and Palestrant patents in further view of U.S. Patent No. 5,178,625 to Groshong (“Groshong patent”). Claims 8 and 13 depend from and further limit claims 4 and 11, respectively. As shown above, even when combined the Ratcliff and Palestrant patents fail to disclose all of the limitations of claims 4 and 11. The Groshong patent does not affect this deficiency. Accordingly, even when combined the Ratcliff, Palestrant, and Groshong patents fail to disclose all of the recited limitations of claims 4 and 11 and, therefore, claims 8 and 13 as well. Therefore, a *prima facie* case of obviousness cannot be established with respect to claims 8 and 13 based on the Ratcliff, Palestrant, and Groshong patents. Thus, Applicants request that the § 103 rejection of claims 8 and 13 be withdrawn.

## **3. Ratcliff, Palestrant, Groshong, and Scribner**

Claims 9, 10, and 15-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Ratcliff, Palestrant, and Groshong patents in further view of U.S. Patent No. 5,972,015 to Scribner et al. (“Scribner patent”). Claims 9 and 10 depend from and further limit claim 4, while claims 15-17 depend from and further limit claim 11. As shown above, even when combined the Ratcliff and Palestrant patents fail to disclose all of the limitations of claims 4 and 11. The Groshong and Scribner patents do not affect this deficiency. Accordingly, even when combined the Ratcliff, Palestrant, Groshong, and Scribner patents fail to disclose all of the recited limitations of claim 4 and 11 and, therefore, claims 9, 10, and 15-17 as well. Therefore, a *prima facie* case of obviousness cannot be established with respect to claims 9, 10, and 15-17 based on the Ratcliff, Palestrant, Groshong, and Scribner patents. Thus, Applicants request that the § 103 rejection of claims 9, 10, and 15-17 be withdrawn.

#### **IV. Conclusion**

It is believed that all matters set forth in the Office Action have been addressed and that all of the pending claims are in condition for allowance. Accordingly, an indication of allowability is respectfully requested.

The Office Action contains characterizations of the claims and the related art to which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in this or any other Office Action.

Should the Examiner deem that an interview with Applicants' undersigned attorney would further prosecution, the Examiner is invited to call the undersigned attorney at the telephone number indicated below.


Respectfully submitted,



Gregory P. Webb  
Registration No. 59,859

Date: September 17, 2009  
HAYNES AND BOONE, LLP  
Customer No. 46333  
Telephone: 972-739-8641  
Facsimile: 214-200-0853  
R-236367\_1.DOC

I hereby certify that this correspondence is being filed with the United States Patent and Trademark Office via EFS-Web on September 17, 2009.

  
Gayle Conner